

THIS DISPOSITION IS NOT CITABLE
AS PRECEDENT OF THE TTAB

MARCH 16, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Edison Brothers Stores, Inc.

v.

Terra Nova Shoes Ltd.

Cancellation No. 22,859

Paul F. Kilmer of Gadsby & Hannah LLP for Edison Brothers
Stores, Inc.

Bruce A. Tassen of Jackson & Kelly for Terra Nova Shoes Ltd.

Before Simms, Seeherman and Chapman, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Edison Brothers Stores, Inc. has filed a petition to
cancel a registration issued to Terra Nova Shoes Ltd. for
the mark WILD SIDER for "footwear."¹

Petitioner asserts as grounds for cancellation that it
owns and operates a number of retail store chains across the

¹ Registration No. 1,828,903, issued March 29, 1994. The
claimed dates of first use and first use in commerce are
September 1989 and October 1992, respectively.

country, including WILD PAIR stores, a chain of approximately 250 stores selling apparel including footwear; that since 1972 petitioner has continuously used the mark WILD PAIR for shoes and for retail stores which include the sale of shoes; that petitioner owns several registrations which include the word WILD, specifically, THE WILD PAIR for shoes and retail store services dealing with the sale of shoes and accessories, WILD PAIR and design marks for shoes, and handbags, hosiery, sweatshirts, pantyhose, socks, shirts and belts, WILD WEAR and design for sweatshirts, pantyhose, socks and shirts, and WILD THINGS and design for jewelry (namely earrings), and shoe ornaments²; and that respondent's mark, when used on its goods, so resembles petitioner's previously used and registered family of marks, as to be likely to cause confusion, mistake, or deception.³

In its answer respondent has denied the salient allegations of the petition to cancel, and raised the affirmative defense that petitioner "is estopped by laches

² In its pleading, petitioner also referenced Reg. No. 1,491,866, issued June 14, 1988 for the mark SOMETHING WILD for men's cologne. Petitioner did not rely on this registration at trial, and we note that subsequent to the filing of the petition to cancel, this registration was cancelled under Section 8.

³ Petitioner alleged that respondent's use of its mark damages petitioner in contravention of Section 32(1) of the Trademark Act. Petitioner is advised that this section of the statute is not applicable to Board proceedings as it refers to a party being "liable in a civil action" and provides for injunctions, and in appropriate cases, damages and profits as remedies for trademark infringement. We have construed this as a pleading under Section 2(d) of the Trademark Act.

and acquiescence" from objecting to respondent's registration because petitioner did not oppose the registration at the application stage after requesting an extension of time to do so.

The record consists of the pleadings; the file of respondent's registration; the testimony of Michael Fine, petitioner's group president of footwear and women's wear; the testimony of Lester D. Cherry, petitioner's president of the Wild Pair stores; the testimony of Robert John Worrall, respondent's vice president of sales and marketing⁴; petitioner's notice of reliance on status and title copies of its registrations; petitioner's notice of reliance on (i) certain of respondent's answers to petitioner's first set of interrogatories, (ii) certain of respondent's answers to petitioner's first requests for admission, and (iii) a photocopy of an unpublished decision from the U.S. District Court for the District of Massachusetts in the case of Edison Brothers Stores, Inc. v. National Development Group, Inc., et al.⁵; and respondent's notice of reliance on 14 third-party registrations.

⁴ This testimony was taken by petitioner during petitioner's testimony period.

⁵ Although petitioner did not cite the Trademark Rule under which the district court decision was offered, we presume that petitioner offered it pursuant to Trademark Rule 2.122(e). We note that petitioner did not indicate the relevance of said decision in the notice of reliance, but petitioner argued in its briefs that the court decision shows that petitioner has policed its family of WILD marks, and that petitioner's mark WILD PAIR and the family of WILD marks are strong. While the decision is

Regarding petitioner's notice of reliance on its registrations, petitioner submitted status and title copies of the following registrations:

- (1) Reg. No. 955,819, THE WILD PAIR for shoes⁶;
- (2) Reg. No. 977,532, THE WILD PAIR for retail store services dealing with the sale of shoes and accessories⁷;
- (3) Reg. No. 1,198,008, for the mark shown below

Wild Pair

for shoes⁸;

- (4) Reg. No. 1,495,801, for the mark shown below



for handbags, and hosiery, sweatshirts, pantyhose, socks, shirts and belts⁹;

incompetent to establish any fact recited therein against respondent, which was not a party to the civil action, see *Sales Analysis Institute, Inc. v. Sales Training, Inc.*, 181 USPQ 341 (TTAB 1973), the decision is admissible for the limited purpose of indicating that petitioner has engaged in efforts to police its WILD PAIR mark.

⁶ Reg. No. 955,819, issued March 20, 1973, Section 8 affidavit accepted, Section 15 affidavit acknowledged, renewed (10 years).

⁷ Reg. No. 977,532, issued January 22, 1974, for Section 8 affidavit accepted, Section 15 affidavit acknowledged, renewed (10 years).

⁸ Reg. No. 1,198,008, issued June 15, 1982, Section 8 affidavit accepted.

(5) Reg. No. 1,482,435, for the mark shown below

The logo for "Wild Wear" features the word "Wild" in a large, bold, serif font, with the word "Wear" in a smaller, similar serif font positioned directly below it.

for sweatshirts, pantyhose, socks and shirts¹⁰; and

(6) Reg. No. 1,530,800, for the mark shown below

The logo for "WILD things" features the word "WILD" in a bold, blocky, sans-serif font, followed by the word "things" in a cursive, script font.

for jewelry (namely earrings), and shoe ornaments¹¹.

Both parties filed briefs on the case.¹² No oral hearing was requested.

The record shows that petitioner, Edison Brothers Stores, Inc., first used the mark THE WILD PAIR for both shoes as well as for retail shoe stores in 1972; that the original merchandise sold in THE WILD PAIR stores included men's and women's shoes and boots, handbags, belts, shoe care products, t-shirts and sun visors; and that the mark

⁹ Reg. No. 1,495,801, issued July 12, 1988, Section 8 affidavit accepted, Section 15 affidavit acknowledged. (Petitioner's pleading referred only to handbags.)

¹⁰ Reg. No. 1,482,435, issued March 29, 1988, Section 8 affidavit accepted, Section 15 affidavit acknowledged. The term "wear" is disclaimed.

¹¹ Reg. No. 1,530,800, issued March 21, 1989, Section 8 affidavit accepted, Section 15 affidavit acknowledged. [Petitioner's pleading referred only to jewelry (namely earrings).]

¹² Petitioner attached an exhibit to its brief on the case which was not previously part of the record. Respondent objected thereto. Respondent's objection is well taken, and the material improperly submitted with petitioner's brief has not been considered.

WILD PAIR has been in continuous use since 1972 for shoes and for retail shoe stores. The record also establishes that petitioner's mark WILD PAIR has been used over the years in a number of different forms. The mark was originally THE WILD PAIR, and THE WILD PAIR within an oval design. More recently, petitioner has used the mark WILD PAIR, presented in various stylized forms. For purposes of simplicity herein, petitioner's mark is referred to as WILD PAIR.

Petitioner currently operates a chain of approximately 200 WILD PAIR shoe stores nationwide, generally located in shopping malls. Petitioner itself is not a manufacturer, but has shoes manufactured for it under its private label WILD PAIR, and petitioner sells men's and women's shoes and boots, including a work boot with a reinforced steel toe. The mark is used, for example, on store signs, shoe boxes and labels, point-of-purchase displays, and shoe sock lining labels (stamped or sewn onto the internal shoe lining); and currently the mark generally appears in red and white, or sometimes in red and black. Petitioner's customers are 70% women and 30% men; and the shoes range in price from \$19-\$150 a pair.

Petitioner's goal in 1972 in creating a new store chain as well as products therefor was to develop a new concept to be in tune with the times and appeal to a more anti-

establishment group of young people, which would be different from the groups targeted by many of petitioner's other store chains. The mark THE WILD PAIR was originally selected to reflect the idea of a unique, fashion-forward, cutting-edge store.

Although petitioner once advertised in national magazines such as Mademoiselle, Gentleman's Quarterly and Rolling Stone, petitioner stopped such advertising in 1990. Petitioner currently advertises its retail stores and products through tie-ins with malls as required by petitioner's leases (e.g., mall newsletters and circulars), and through local newspapers. The nature of such advertisements is intended to target the 18-35 year-old person who is on the leading edge of fashion, trendy, and likely to accept and adopt new fashion trends. In addition, petitioner exhibits at trade shows in New York and Las Vegas.

During the years 1989 through 1996, petitioner's advertising expenses were approximately \$1,000,000 annually.¹³ Total annual sales at WILD PAIR retail stores grew from \$123,000,000 in 1989 to a high of \$146,000,000 in 1992, then fell back to \$96,000,000 in 1996. Petitioner's

¹³ Lester D. Cherry testified as to the advertising figures for the years 1989-1993, and they were defined as "advertising and promotional expenses in relation to its WILD PAIR and 'WILD' family of marks for products and services" (Cherry Dep., Ex. 27). Michael Fine testified as to the advertising figures for

sales of footwear grew from \$106,000,000 in 1989 to a high of \$129,000,000 in 1992, then fell back to \$72,000,000 in 1996.¹⁴

Respondent is a Canadian corporation, founded in 1971, which manufactures shoes and boots, primarily industrial footwear for men and women, but including some outdoor, nonsafety footwear. Respondent manufactures footwear both with and without steel toes and/or steel plates. Respondent first used the mark WILD SIDER¹⁵ in 1987, with the first sale in the United States in 1991, following respondent's participation at the Las Vegas trade show. Fashion industry representatives approached respondent when work boots became fashionable several years ago. Approximately 25% of respondent's sales to the United States are under the mark WILD SIDER, with the other 75% consisting primarily of private brands. Respondent sells both industrial and outdoor footwear under the mark WILD SIDER, and the mark is used on all of respondent's "better quality industrial and better quality nonindustrial footwear," which accounts for

the years 1994-1996, and these numbers were defined as "advertising and display" expenses (Fine Dep., Ex. 63).

¹⁴ Lester D. Cherry testified as to the footwear sales figures for the years 1989-1993, and they were defined as "shoes and footwear bearing a mark comprising a part of [petitioner's] 'WILD' family of marks" (Cherry Dep., Ex. 26). Michael Fine testified as to the footwear sales figures for the years 1994-1996, and these numbers were defined as "sales with [a] WILD PAIR label" (Fine Dep., Ex. 63).

¹⁵ Respondent also refers to use of the mark TERRA WILD SIDER, but because the registered mark is WILD SIDER, our decision will be limited thereto. Like petitioner, respondent has also

70% of respondent's business (Worrall Dep., p. 48).

Respondent sells to distributors (primarily industrial distributors) and/or retailers.

The mark WILD SIDER is intended to denote a youthful, aggressive, alternative fashionable image, with Mr. Worrall testifying that "Wild Side" was designed to conjure up an alternative image, with the idea of the commonly used expression "walk on the wild side" (Worrall Dep., pp. 74-76). A hang tag used until 1992 or 1993 includes, inter alia, the following statement: "With a choice of casual or safety styles, it's easy to see why this footwear is the first choice of those who walk on the Wild Side." The hang tag currently in use states, in part, as follows: "Wild Siders. An amazing blend of wild-tech and ancient crafts.....The legend of wild-tech. Terra Wild Siders."

The mark is used on sewn-on fabric shoe tongue labels, on hang tags, and on shoe boxes. The mark appears in red, white and black.

Around 1993 respondent advertised in the "SF Weekly" (San Francisco) and the "L.A. Weekly," but respondent has not run any such advertisements recently. Some of respondent's customers (generally distributors) feature respondent's products in their catalogues, and respondent created its own catalogue in 1993 for use by respondent's

changed the graphic design of the mark WILD SIDER over the years.

customers. Today respondent produces a series of flyers for its customers. Also, respondent advertised in trade publications, Footwear Plus and Footwear News, in the United States in 1995 and 1996.

Respondent's target market is the 18-35 age group, both men and women, but its customers are 99% male, and 98% purchase respondent's products because of the utility or safety factor of the footwear. The prices of respondent's shoes/boots range from \$80-\$140. Respondent's sales in the United States grew from \$4,000 in 1991 to a high of \$109,000 in 1996, and then fell back to \$61,000 in 1997.

The record clearly establishes petitioner's priority. Further, in a cancellation proceeding a petitioner may rely on its registration for the purpose of proving that the mark was in use as of the filing date of the application which matured into its registration. See *Brewski Beer Co. v. Brewski Brothers Inc.*, 47 USPQ2d 1281, 1284 (TTAB 1998). In the case now before us, petitioner's filing dates of its WILD PAIR applications which matured into registrations are all prior to the filing date of respondent's application which matured into its registration. Aside from the fact that petitioner owns registrations with prior application filing dates for its involved mark, the testimony by petitioner's president of the Wild Pair stores, Lester D. Cherry, establishes petitioner's continuous use of the mark

WILD PAIR on shoes and for shoe stores since 1972, whereas, the testimony by respondent's vice president, Robert John Worrall, establishes that respondent first used the mark WILD SIDER in the United States in 1991. Thus, petitioner has demonstrated priority.

We turn then to the issue of likelihood of confusion. Our determination of this issue is based on an analysis of all the probative facts in evidence that are relevant to the factors bearing on likelihood of confusion. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). As dictated by the evidence, different factors may play more dominant roles in determining likelihood of confusion. See *Nina Ricci, S.A.R.L. v. E.T.F. Enterprises*, 889 F.2d 1070, 12 USPQ2d 1901 (Fed. Cir. 1989).

The Board must consider the goods and/or services as set forth in the registrations. See *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); and *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983). The goods listed in petitioner's registrations are "shoes" and its listed services are "retail store services dealing with the sale of shoes and accessories." Respondent's mark is registered for "footwear." It is indisputable that the parties' goods are, for our purposes, legally identical, and that petitioner's services are very closely related to respondent's goods.

Because there is no restriction in either parties' respective registrations for goods as to trade channels and/or class of purchasers, it must be assumed that the goods move through all normal channels of trade for shoes/footwear, and they are available to all such prospective purchasers. See *Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991). In point of fact, the record shows that both parties sell, inter alia, boots, both with and without steel reinforced toes.

We next address petitioner's claim of a family of "WILD" marks. Petitioner submitted status and title copies of seven registrations (including one that was not pleaded, and excluding one that was pleaded¹⁶.) Aside from the registered marks THE WILD PAIR and WILD PAIR, petitioner's "family" of marks, as evidenced by the status and title copies of the registrations, consists of the mark WILD THINGS and design for shoe ornaments, and the mark WILD WEAR for sweatshirts, pantyhose, socks, and shirts.

It is well settled that mere adoption, use and registration of a number of marks having a common feature

¹⁶ The registration that was pleaded but not submitted under the notice of reliance is Reg. No. 1,491,866 for the mark SOMETHING WILD for men's cologne, which has been cancelled under Section 8 of the Trademark Act.

The registration that was not previously pleaded but was submitted is Reg. No. 1,055,380 for the mark DR. WILD'S and design for shoe polish, which expired in 1997. The Board hereby takes judicial notice that petitioner's Reg. No. 1,055,380 has expired. See TBMP §703.02(a), at page 700-10, and cases cited therein.

(e.g., the term WILD) for similar or related goods or services does not in and of itself establish a family of marks. Rather, in order to establish a family of marks, it must be demonstrated that the marks asserted to comprise the "family", or a number of them, have been used and advertised in promotional material or used in everyday sales activities in such a manner as to create common exposure and thereafter recognition of common ownership based upon a feature common to each mark. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Witco Chemical Co. v. Whitfield Chemical Co.*, 418 F.2d 403, 164 USPQ 43 (CCPA 1969); *Hester Industries Inc. v. Tyson Foods Inc.*, 2 USPQ2d 1646 (TTAB 1987); and *Dan River, Inc. v. Apparel Unlimited, Inc.* 226 USPQ 186 (TTAB 1985).

Petitioner has offered evidence regarding its use of the mark WILD PAIR, but has failed to offer evidence as to the specifics of the promotion or use of any other marks in its asserted family of "WILD" marks, including WILD WEAR and WILD THINGS. While petitioner owns a registration for the mark WILD WEAR covering sweatshirts, pantyhose, socks and shirts, Mr. Cherry was uncertain of the dates of use and of the specific products on which the mark was used. Further, he testified that the volume of goods and dollar value of goods sold under the mark WILD WEAR was "minimal" (Cherry

Dep., p. 103); and that he could not think of any other specific "WILD marks" used and protected by petitioner.

Accordingly, we find that petitioner's evidence is wholly inadequate to establish a family of marks.

Petitioner did not specifically allege that respondent's mark is likely to cause confusion with each of the asserted family members, but rather, petitioner argued only very generally that respondent's mark is likely to cause confusion with petitioner's family of marks. See *Colony Foods, Inc. v. Sagemark, Ltd.*, 735 F.2d 1336, 222 USPQ 185 (Fed. Cir. 1984). Accordingly, we confine our consideration of likelihood of confusion to petitioner's WILD PAIR marks.

Turning next to a consideration of the marks, we find that the marks are sufficiently dissimilar in sound, appearance, meaning and commercial impression that consumers are not likely to be confused. The only term they share is the word WILD. However, in petitioner's mark the term WILD describes the term PAIR, relating to shoes, such that petitioner's mark connotes a unique or outlandish pair of shoes. Respondent's mark, WILD SIDER, on the other hand, we believe may suggest to consumers a "walk on the wild side" of life. In fact, respondent testified that that was the image respondent intended to create. Accordingly, the marks are different in connotation.

The differences between the marks WILD PAIR and WILD SIDER, when they are considered in their entirety, avoids any likelihood of confusion or mistake as to the source of the goods and services sold thereunder. See *Fort Howard Paper Company v. Marcal Paper Mills, Inc.*, 189 USPQ 305 (TTAB 1975).

Petitioner contends that its mark WILD PAIR is famous, asserting that fame is established by its many years of use, large volume of sales, substantial promotion and advertising, and unsolicited publicity. We acknowledge that the record shows that petitioner has used its mark for over 20 years for shoes and retail shoe store services; and that petitioner has submitted figures showing sales and advertising expenses for several years, as well as several articles or stories about petitioner which have appeared in various publications.

Petitioner's sales figures for footwear for 1988-1993 indicate that they include all products sold under petitioner's alleged "WILD" family of marks. That is, these figures do not show sales of shoes sold under the specific mark WILD PAIR. The sales figures for footwear for 1994-1996 indicate that these are for sales of products sold under the WILD PAIR label, but there is no indication what percentage of the sales are for shoes, as opposed to sales of other goods such as shoe accessories, handbags, etc.

That is, these figures do not specifically show sales of shoes sold under the mark WILD PAIR. Likewise, the promotional and advertising figures for 1988-1983 indicate that these numbers include petitioner's alleged "WILD" family of marks. Thus, we cannot ascertain from the record the dollar amount for advertising of shoes sold under the mark WILD PAIR. Also, petitioner's witness, Lester D. Cherry, testified that the advertising expenses could include some shipping of materials to the stores (Cherry Dep., p. 86).

While petitioner's sales and advertising figures are large numbers, the specific dollar amounts relating to shoes sold under the mark WILD PAIR has not been substantiated by petitioner. Moreover, petitioner has not placed these sales and advertising figures in overall context relative to the sales and advertising of competitors. See *Fossil Inc. v. Fossil Group*, 49 USPQ2d 1451, 1457 (TTAB 1998); and *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, 1277 (TTAB 1992).

Petitioner's witness Michael Fine testified that WILD PAIR and the WILD PAIR stores have been mentioned in news articles, and introduced eight articles as exhibits (Fine Dep., p. 15-16). Upon review of these articles, we note there are stories from "Footwear News," a trade publication; "Shopping Center World," a trade publication for the mall

industry¹⁷; and six one-page stories which appear to have been provided to petitioner from a press clipping service (one of which is an illegible photocopy, and one of which bears only the geographic identifier "Chicago Met Area"). Some of these one-page "articles" merely indicate that the person/model pictured is wearing shoes by WILD PAIR; others make only a minor reference within a column covering a variety of topics. For example, the "Around The Malls" article mentions that there is a liquidation sale at a WILD PAIR store.

Lester Cherry also testified as to petitioner's publicity. Specifically, he identified four articles appearing in "Footwear News," the trade publication; one in "Adweek," a trade publication of the advertising business; and one in the October 29, 1990 "St. Louis Post-Dispatch" (the city where petitioner is apparently headquartered). He also testified that there are several references to petitioner in "Footwear News," and local newspapers and publications have included articles about petitioner's stores and its goods. (Cherry Dep., p. 43). Most of the articles submitted with the Cherry deposition appeared in trade or business publications, which are not necessarily distributed to the general public.

¹⁷ The article in this case dealt with, inter alia, petitioner's declaration of bankruptcy in 1995.

The publicity testified to and made of record by Messrs. Fine and Cherry is not sufficient to persuade us that the ordinary consumer would see the stories and, as a result of this publicity and petitioner's sales and advertising, would recognize petitioner's mark as famous. Thus, we can only speculate as to the actual impact of petitioner's mark WILD PAIR in the minds of the purchasing public; we must also speculate as to the specific dollar volume of sales and advertising for petitioner's specific involved mark. Based on this record, we are not convinced that petitioner's mark is famous.

Respondent has introduced thirteen third-party registrations, all of which include the word WILD, and all of which are for boots, shoes, or some type of footwear. These marks include, WILD COUNTRY, WILDCATS, WILDFLOWER and design, WILD RICE, WILD BOYS and design, WILD LOON, WILD HORSES, WILD WINDS and design, WILD WIGGLY and design, WILD ROSE, and WILD WOMAN NOTHING DOMESTIC ABOUT HER and design. Inasmuch as third-party registrations are not evidence of use of the marks shown therein, or that the public is familiar with them, these third-party registrations have been accorded little weight in our determination of likelihood of confusion. See *Helene Curtis Industries, Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989).

Finally, the absence of any instances of actual confusion, while weighing in respondent's favor, is not a crucial factor in this decision, given the relatively small amount of respondent's sales in the United States.

We find that, based upon a consideration of all relevant du Pont factors, confusion as to source is not likely between respondent's mark WILD SIDER and petitioner's mark WILD PAIR, when these marks are used on the respective goods and services of the parties.

In view of our decision, we will only briefly discuss respondent's affirmative defense that petitioner is "estopped by laches and acquiescence". We note that the petition to cancel was filed within six weeks of the issuance of the registration. See *National Cable Television Association Inc. v. American Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1991). Further, petitioner submitted under a notice of reliance respondent's responses to certain of petitioner's requests for admission which include admissions that petitioner wrote to respondent in April 1993 and February 1994 regarding its intention to pursue a petition to cancel, and respondent acknowledged petitioner's April 1993 letter. Respondent has not shown any specific action that it took to its detriment based on its alleged reliance on petitioner's failure to act more promptly. For all of these reasons, respondent's defense of

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estoppel by laches and acquiescence fails. See Charrette Corp. v. Bowater Communication Papers Inc., 13 USPQ2d 2040 (TTAB 1989).

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Decision: The petition to cancel is dismissed.

R. L. Simms

E. J. Seeherman

B. A. Chapman
Administrative Trademark
Judges, Trademark Trial and
Appeal Board